

## REMARKS/ ARGUMENTS

The foregoing Amendment After Final and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

### 35 U.S.C. § 103(a) Rejections

Examiner rejected claims 109-136 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,223,165 (hereinafter "Lauffer").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

The Lauffer reference does not disclose the claimed limitation, or a limitation similar thereto as included in the independent claims, of a displaying a list of service providers to a customer via an internet connection with the customer prior to the customer submitting a question, *Including providing the customer with an option to view, In ascending or descending order, the list of service*

*providers according to one of a group consisting of price, availability, and customer evaluations.*

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In addition, a statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

In the present matter, there is no objective reason to combine the official notice that it is well-known in the art to rank various items and display the results of such a ranking in ascending or descending order with Lauffer.

In addition, a statement that modifications of the prior art to meet the claimed invention would have “ ‘well within the ordinary skill of the art at the time claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

As a result, applicants' independent claims are patentable over the Lauffer reference in view of the examiner's official notice. Furthermore, the remaining dependent claims, by way of being dependent on the independent claims, include the distinguishing claim limitations discussed above, and are therefore also patentable over the Lauffer reference.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

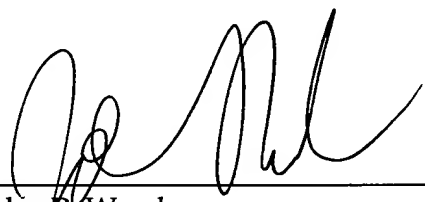
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: \_\_\_\_\_

5/24/04

  
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John P. Ward  
Reg/No. 40,216

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026  
(408) 720-8300